

## REMARKS

Reconsideration of this application, as amended, is respectfully requested.

In the Final Official Action, the Examiner rejects claims 35-54 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,766,189 to Matsuno (hereinafter "Matsuno").

In response, independent claims 35 and 45 have been amended to clarify their distinguishing features. The amendment to claims 35 and 45 are fully supported in the original disclosure. Thus, no new matter has been entered into the original disclosure by way of the present amendment to claims 35 and 45.

The Examiner in the Response to Arguments states "As to argument that the invention is disposable. Any device can be disposable if it is able to be thrown away". However, in the clip device of Matsuno, since the parts that are shown in the Figs. 1A-1D are detachable, then it is possible that they can be reused. Claims 35 and 45 have been amended to clarify such a distinction. Claim 45 has been further amended to avoid redundancy with claim 35.

Specifically, claims 35 and 45 now expressly recite a non-reusable disposable clipping device. Although such limitation appears in the preamble of both independent claims 35 and 45, the same gives life and meaning to features already recited in the body of claims 35 and 45. With regard to independent claim 35, the same recites that:

"the coupling member is rendered irreclaimable (i.e., so as to be incapable of reuse) while being kept fixed with the actuating wire, released from the clip unit, and remains at the distal end of the actuating wire." (emphasis and parenthetical information added)

Similarly, independent claim 45 recites that:

“the coupling member is deformed into an irreclaimable state (i.e., so as to be incapable of reuse) while being kept fixed with the actuating wire, released from the clip unit, and remains at the distal end of the actuating wire.” (emphasis and parenthetical information added)

Thus, such features are to be given patentable weight in determining the patentability thereof. In this regard, Applicants respectfully submit that none of the cited references disclose or suggest such features. As discussed above, in the clip device of Matsuno, since the parts that are shown in the Figs. 1A-1D are detachable, it is possible that they can be reused.

With regard to the rejection of claims 35-54 under 35 U.S.C. § 103(a), independent claims 35 and 45, as amended, are not rendered obvious by the cited reference because the Matsuno patent whether taken alone or in combination with the knowledge of those of ordinary skill in the art, does not teach or suggest a disposable clipping device having the features discussed above and recited in independent claims 35 and 45. Accordingly, claims 35 and 45, as amended, patentably distinguish over the prior art and are allowable. Claims 36-44 and 46-54, being dependent upon claims 35 and 45, are thus at least allowable therewith. Consequently, the Examiner is respectfully requested to withdraw the rejection of claims 35-54 under 35 U.S.C. § 103(a).

In view of the above, it is respectfully submitted that this application is in condition for allowance. Accordingly, it is respectfully requested that this application be allowed and a Notice of Allowance issued. If the Examiner believes that a telephone

conference with Applicants' attorneys would be advantageous to the disposition of this case, the Examiner is requested to telephone the undersigned.

Respectfully submitted,



Thomas Spinelli  
Registration No.: 39,533

Scully, Scott, Murphy & Presser, P.C.  
400 Garden City Plaza, Suite 300  
Garden City, New York 11530  
(516) 742-4343  
TS:cm